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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,229	05/07/2001	Sung Rong Jo	P0239/US/SH	8060

7590 12/09/2004  
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EXAMINER

KRAMER, DEVON C

ART UNIT PAPER NUMBER

3683

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/849,229

**Applicant(s)**

JO, SUNG RONG

**Examiner**

Devon C Kramer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6-10, 12-21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 5 11 22 24 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/02/04 has been entered.

### ***Claim Rejections - 35 USC § 103***

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) Claims 1, 5, 7, 11, 14, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (5096029) in view of Weisenberger (4064910).

Re: claims 1, 22 and 24-25. Bauer et al show in figure 2 a gas opening/closing pin 23 which opens and closes a gas inlet and outlet 55 formed in a pipe holder 12 which seals one end portion of a cylinder 1 and moves the position of a piston 21 in the cylinder, wherein at least one recess portion d" which opens the gas inlet and outlet is formed on a side of the outer peripheral surface of the central portion of the gas opening/closing pin and one of an integrally formed washer-shaped boss body portion

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(46) is formed at a lower end of the opening/closing pin. Bauer et al lacks the teaching of the streamlined recess not extending around the entire outer periphery of the central portion.

Weisenberger teaches a streamlined recess (30) on a pin member that does not extend around the entire outer periphery of the central portion.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the pin of Bauer et al with the streamlined recess as taught by Weisenberger merely to provide a communication channel adjacent the port and to cut down on the machining costs.

In re claim 5, Bauer et al teaches the pin as a bar. The dictionary defines a bar as metal or wood. Col. 3 lines 25-27

Re: claim 7, Bauer et al., as modified, describe the invention substantially as set forth above, but are silent as to the gas opening/closing pin being a non-metal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pin of Bauer et al to have been made of non-metal to provide a pin that is structurally durable or non-corrosive, respectively, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Re: claim 11. Bauer et al as modified by Weisenberger, describe the invention substantially as set forth above, but fail to show the limitation of the at least one recess

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portion comprising a plurality of streamlined-shaped recesses. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pin of Bauer et al, as modified by Weisenberger, to have included a plurality of streamlined recesses to increase the total amount of fluid flow through the pin since in *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

### ***Response to Arguments***

4) Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive. Applicant argues that the streamlined recess of Weisenberger extends around the entire circumference of the central portion. The examiner is using portion 30 as the streamlined recess. It is advised that applicant amend the claims to cite language further describing the streamlined recess. The streamlined recess of Weisenberger contacts an annular groove that does extend around the entire circumference of the central portion.

In response to applicant's argument that introduction of the pin of Weisenberger into the device of Bauer et al would destroy the device of Bauer and thus not obvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).


***Conclusion***

5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 703-305-0839. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DK

  
12/2/04